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OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023			EXAMINER DICUS, TAMRA	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/749,087

**Applicant(s)**

BERDAN ET AL.

**Examiner**

TAMRA L. DICUS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/01/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The previous 112 second paragraph and 103 over claims 4, 6 and 10-19 are withdrawn.

Applicant's arguments filed 07/01/08 have been fully considered but they are not persuasive.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the veil (claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or

“New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

Claims 4-5 and 7-8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claims do not constitute a further limitation because the claims do not refer to a preceding claim. See also MPEP 608.01 (n).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 4-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a compressed first material extending throughout the one peripheral edge and having a second density greater than the first. It was not set forth originally that compressed material extends throughout both the edge and body. See [0046-0048] explaining a core or frame extension beyond or below, but not throughout and not a compressed material either as it appears to be of uncompressed material. Thus, the added limitations appear to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, and 4-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites an edge portion that is formed of a compressed first material. It is not clear what extends throughout and has a second density (an edge portion or a compressed first material). And if what extends having a second density is the edge, then it is contradictory because it is of the first material having a first density or it is confusing as to if it has both a first and second density (and if it has a second density then it would correspondingly have to have a second material) or separately in different areas of the edge

portion. The specification lacks guidance to these issues and thus it is not understandable because it is not clear.

Claim 5 is not clear because it appears from claim 1 that the edge is not a part of the main body since it's positioned at a side, so it is not clear how it is formed by compressing portions of the main body.

To claim 6, it is not clear if said decorative surface refers to the sheet or edge portion. Similar rationale applies to claim 7. Further to claim 7, it is not clear to what (maybe a substrate) it appears to be put on the second material; basically it's not clear where the second material is in order for the decorative surface to be put on it, i.e. on the main body of the first material or on the edge of the first material or on another section not identified. Also "said top major surface" lacks antecedent basis. Similar rationale applies to claims 8-9.

To claim 10, it is not clear if the reinforced edge is a rotated flange, or the rotated flange the compressed fibers, it's not clear if they are separate elements or one, and when referring to rotated flanges, it is further not clear what is being rotated, the edge or flange or both. The claim appears jumbled with this language and is not clear.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Heller (US 3,907,193).

Heller teaches a plastic sheet material container. This is seen as functioning as an acoustic panel since the same material and structure is taught, see MPEP 2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. Consequently, “preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.” In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). The patent further teaches the container joined by fold lines and compressed (6:55-65) and the sheet material

between and throughout (because the same material is present in the body and on the body's edges) the indentations (peripheral edge) being greater density than the density of the sheet material away from the fold lines (main body having sides as claimed). Additionally the sheet material of the container can be folded on itself (see FIG. 3 showing fold point, compressed regions, and four surfaces) to form the container. See patented claim 1, Abstract, 2:30-60, 3:25-65. The plastic sheet is made of materials suitable for use in making boxes or cartons (4:30-45) such as polystyrene. While Heller does not use the same wording, the sheet material of the same material is inherently decorative. Claims 1 and 5 are met.

Further to claims 5, 7-9 product by process limitations such as formed by rotating, as recited are given little weight in a product claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698. Both Applicant's and prior art reference's product are the same.



- Applicant argues this rejection, but because the claims are still confusing, and thus this rejection is still upheld.
- Moreover, Applicant admits there is shown compaction of the material, but no other compression (pointing to FIG. 1 components 12, 14); however, this is not claimed. Therefore, because the material is compacted and folded, at the point of compression, it is considered compressed.

Claims 1, and 5-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879).

Schumacher teaches a variety of synthetic fibers (first thermoplastic material) included in the body 2 and having an edge flap 8, 9 shown folded and tucked in the body of 2 in Fig. 3 (and therefore rotated and compressed) of compressed fibers (see 3:55-60, 4:1-3, 4:65-75). This is seen as functioning as an acoustic panel since the same material and structure is taught, see MPEP 2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. Consequently, “preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant.” In *Poly-*

*America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004). The inner region that is compressed is inside the innermost of the tucked part, the outer region outermost side (while not identified, see the regions laterally extending to the right of 8 and 9 in Fig. 3). Because the body and edge are of the same fibrous material, it extends throughout the edge. See also 3:50-60. The fibers are compressed to absorb shock and can be compressed without the loss of loft. Crimped and, curled, fibers also may be used give greater loft than the same amount of straight fibers, which means an inherent lesser density is provided. Therefore this implies use of the crimped or curled have a lesser density (at the fold or compressed regions) than the straight fibers (not around the compressed part - the regional area furthest away from the point where the flap folds). See 4:1-25.

Alternatively, if objective evidence proving that the claimed effective density is not inherent in Schumacher, then it would have be obvious to have effected the density because Schumacher teaches compressed or straight fibers effect the loft and resultant density and thus choosing the type of fiber effects the density, and thus the density is a result-effective variable as it effects the loft of the overall package. It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves

only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). See also MPEP § 2144.05 II (B). Moreover, dependent upon the variety of thermoplastics chosen for the synthetic fibers, the inherent density of the polymer itself may be greater or lesser dependent upon the obvious choice of material to yield the desired density.

A backing sheet 4 of paper and a facing fibrous sheet are secured on the body 2 and is equivalent to a decorative veil and a second material. There are several flanges and edges in a non-linear shape shown in Fig. 3.

Further to claims 1, 4-5, and 7-19, product by process limitations such as formed by rotating, as recited are given little weight in a product claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698. Both Applicant's and prior art reference's product are the same. Claims 1, 5-19 are met.

Further to designs on the edge (claim 13), it would have been obvious to have decorated it for instruction or aesthetic purposes. Motivation need not be found in the references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or

the nature of the problem itself. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Hoeschele*, 406 F.2d 1403, 1406-407, 160 USPQ 809, 811-12 (CCPA 1969).

Claim 6, and 10-12, are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller (US 3,907,193) in view of S.P. Schumacher (US 3,096,879).

Heller essentially teaches the claimed invention, the features relied upon above.

There are several flanges and edges in a non-linear shape shown in FIG. 5 of Heller.

Heller does not teach an additional second material affixed to the main body as per claim 6 or a reinforcing edge on a body formed by compressing an outer region forming compressed fibers of the flange (claim 10), or how the flanges are folded (claims 16-19).

Schumacher teaches a variety of synthetic fibers (first thermoplastic material) included in the body 2 and having an edge flap 8, 9 shown folded and

tucked in the body of 2 in Fig. 3 (and therefore rotated and compressed) of compressed fibers. The inner region that is compressed is inside the innermost of the tucked part, the outer region outermost side (while not identified, see the regions laterally extending to the right of 8 and 9 in Fig. 3). Because the body and edge are of the same fibrous material, it extends throughout the edge. See also 3:50-60. The fibers are compressed to absorb shock and illustrated as compressed in Fig. 3 and can be compressed without the loss of loft. See 3:55-65, 4:1-10, 4:65-75. Crimped and, curled, fibers also may be used give greater loft than the same amount of straight fibers, which means an inherent lesser density is provided. Therefore this implies use of the compressed or crimped or curled fibers for straight ones. See 4:1-25. A backing sheet 4 of paper and a facing fibrous sheet are secured on the body 2 and is equivalent to a decorative veil and a second material. There are several flanges and edges in a non-linear shape shown in Fig. 3.

It would have been obvious to one having ordinary skill in the art to have modified Heller to include a second material veil and compressed fibers to assist in packaging and effect loft to foldable products as cited above by Schumacher.

Further to the process steps of claim 10, product by process limitations such as rotating, are given little weight in a product claim. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability

of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698. Both Applicant's and prior art reference's product are the same.

- Heller is still used in this rejection because it teaches the compressed material having the density relationship requirement, despite Applicant's arguments to the previous combination, thus because a new reference is employed, the rejection is now over the above combination and arguments are moot. The combination, not just Heller alone (as Applicant appears to argue), is an obvious combination for the reasons set forth above.

Claim 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable Heller (US 3,907,193) in view of S.P. Schumacher (US 3,096,879) and further in view of US Hoffman, Jr. (US 3835604 A).

The features of the combination are relied upon above. There are several flanges and edges in a non-linear shape shown in FIG. 5 of Heller forming a package or container (claims 15-19). Bonding the edge to the main body is known to increase interfacial adhesive strength and double folding a flap would

have been obvious depending on what the container is to fit the desired size (claim 15).

The combination does not teach decoration as per instant claim 13.

Hoffman, Jr. teaches a similar folded facing and insulation panel wherein a principal objective of his invention is to provide building insulation of the general kind referred to with a facing sheet having a decorative pattern such as indicia, so that the installed appearance of the insulation is aesthetic or attractive (1:40-55, 4:1-15, Fig. 1 and Fig. 1a and associated text

It would have been obvious to one having ordinary skill in the art to have modified the panel of the combination to include decoration as claimed for aesthetic or attractive appearance as taught by Hoffman, Jr. cited above. While the decoration is shown on the edges, it would have been obvious to extend it throughout the entire body to further make the entire panel attractive.

- Hoffman is still used in this rejection because it teaches further the obvious addition of having a decoration on edges of material, despite Applicant's arguments to the previous combination, thus because a new reference is employed, the rejection is now over the above combination and arguments are moot.

Claim 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heller (US 3,907,193) in view of S.P. Schumacher (US

3,096,879) and further in view of Hoffman, Jr. (US 3835604 A) and further in view of Chenoweth (US 4946738).

The combination is applied above.

The references do not teach using bicomponent fibers as per claims 4 and 14.

Chenoweth teaches a nonwoven material comprising a matrix consisting of glass fibers, solid or hollow homogeneous synthetic fibers, such as polyester, nylon and second, bi-component synthetic fibers which have been intimately combined with a thermosetting resin into a homogeneous mixture. This mixture is dispersed to form a blanket and melted to be formed into complexly curved and shaped configurations. See 1:1-30, 3:1-10, 4:30-68, Abstract.

It would have been obvious to one having ordinary skill in the art to have modified the combination to include bicomponent polyester fibers as claimed because Chenoweth teaches the fibers are used for reinforcement purposes and for insulating characteristics in curved and shaped configurations and panels as cited above. To the application of heat and bonding process steps, these are in a product claim, given little weight. See product by process rationale above.

- Chenoweth is still used in this rejection because it teaches further the obvious addition of bicomponent fibers for reinforcement, despite Applicant's arguments to the previous combination, thus because a



new reference is employed, the rejection is now over the above combination and arguments are moot.

Claim 4 is rejected under 35 U.S.C. 103(a) as obvious over S.P. Schumacher (US 3,096,879) in view of Chenoweth (US 4946738).

Schumacher is applied above.

Schumacher does not teach using bicomponent fibers as per claim 4, while as said above teaching any synthetic fiber may be used (see again 2:15-30).

Chenoweth teaches a nonwoven material comprising a matrix consisting of glass fibers, solid or hollow homogeneous synthetic fibers, such as polyester, nylon and second, bi-component synthetic fibers which have been intimately combined with a thermosetting resin into a homogeneous mixture. This mixture is dispersed to form a blanket and melted to be formed into complexly curved and shaped configurations. See 1:1-30, 3:1-10, 4:30-68, Abstract.

It would have been obvious to one having ordinary skill in the art to have modified the Schumacher to include bicomponent polyester fibers as claimed because Chenoweth teaches the fibers are used for reinforcement purposes and for insulating characteristics in curved and shaped configurations and panels as cited above. To the application of heat and bonding process steps, these are in a product claim, given little weight. See product by process rationale above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The

fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

September 23, 2008